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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,129	01/20/2004	Hiromu Ando	Q79438	6649

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EXAMINER	
LAMB, BRENDA A	

ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/759,129	ANDO ET AL.	
	Examiner	Art Unit	
	Brenda A. Lamb	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 May 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) *8-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/29/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's election without traverse of Group I in the reply filed on 5/04/2005 is acknowledged.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2 and 4-7 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-3, 6, 9 and 19-21 of copending Application No. 10/437,973 (Kanke et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because Kanke et al '973 claims method and apparatus for coating a coating liquid on a surface of a belt body or strip shaped body which is conveyed in a certain direction, the coating device comprising: a first side bar which extends along a width direction which is transverse of the conveyance of the conveyance plane, wherein the conveyance plane includes the conveyance path of the strip-shaped body; a second side bar at a downstream side relative to the first bar, which extends in parallel with the first side bar; a coating liquid supply channel, which supplies the coating liquid at an upstream side at the first side bar; a inter-bar liquid –pooling section which reads on applicant's claimed between-bars

liquid reservoir located between the first side bar and the second side bar, which accumulates the coating liquid at a time of coating of the coating liquid; and an air – liquid boundary surface formation apparatus which reads on applicant's claimed air – liquid interface forming portion which forms an air-liquid interface at the inter-bar liquid-pooling section. The functional recitation the coating amount at the primary bar is greater than the coating amount at the secondary bar such as set forth in claim 1-2 has not been given patentable weight because it is narrative in form. In order to e given patentable weight, functional recitation must be expressed as a "means" for performing the specified, as set forth in 35 USC 112, 6th paragraph, and must be supported by recitation Miller in the claim of sufficient structure to warrant the presence of the functional recitation. In re Fuller, 1929 C.D. 172; 388 O.G.279. In any event, Kanke et al '973 claims the amount of coating supplied at the downstream side of the second bar is controlled independently from a supplied amount of the coating to the upstream side of the first bar. Therefore, the claimed Kanke et al '973 apparatus is obviously capable of being operated such that coating amount at the primary bar is greater than the coating amount at the secondary bar such as set forth in claim 1 or the ratio of the coating amount at the primary bar relative to the secondary bar is within the scope of claim 2 as the result of the independent flow control of the coating supplied at the downstream side of the second bar relative to the flow of coating to the upstream side of the first bar. Thus claims 1-2 and 4 are obvious over Kanke et al '973. With respect to claim 5, Kanke et al '973 claims a coating liquid suction opening portion in the air-liquid interface portion and the coating liquid suction opening portion is capable of sucking the

material in communication therewith, which in this case is the coating liquid stored in the between –bars liquid reservoir. With respect to claim 6, Kanke et al '973 claims a primary coating liquid flow path for supplying the coating to the upstream side of the first bar. Kanke et al '973 claims a connecting channel which includes a coating liquid suction opening connects the between –bars liquid reservoir and primary flow path. With respect to claim 7, Kanke et al '973 is capable of coating a substrate within the scope of claim since it teaches every positively claimed element of the apparatus.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-2 and 7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-21 of copending Application No. 10/219,812 (Kanke et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because Kanke et al '812 claims a coating device for providing a coating liquid on a surface of a belt body or strip-shaped body which is conveyed in a certain direction, the coating device comprising: primary bar or metering rod which extends along a width direction which transverse of the conveyance plane, wherein the conveyance plane includes the conveyance path of the strip-shaped body; a secondary bar or auxiliary bar at a downstream side relative to the primary bar, a between –bars liquid reservoir or auxiliary feeding device arranged between primary bar and secondary bar for feeding coating and thereby temporarily storing coating in an area between the primary bar and secondary bar. The functional recitation the coating amount at the primary bar is greater than the coating amount at

the secondary bar such as set forth in claims 1-2 has not been given patentable weight because it is narrative in form. In order to be given patentable weight, functional recitation must be expressed as a "means" for performing the specified, as set forth in 35 USC 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional recitation. In re Fuller, 1929 C.D. 172; 388 O.G.279. with respect to claim 7, Kanke et al '812 is capable of coating a substrate within the scope of claim since it teaches every positively claimed element of the coating apparatus.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Gottwald .

Gottwald claims a coating device for coating a coating liquid on a surface of a belt body or strip –shaped body which is conveyed in a certain direction, the coating device comprising: primary bar or metering rod which extends along a width direction which is transverse of the conveyance plane, wherein the conveyance plane includes the conveyance path of the strip-shaped body; a secondary bar or auxiliary bar at a downstream side relative to the primary bar, a between –bars liquid reservoir or auxiliary feeding device arranged between primary bar and secondary bar for feeding and thereby temporarily storing the coating in an area between the primary bar and secondary bar. The functional recitation the coating amount at the primary bar is greater than the coating amount at the secondary bar such as set forth in claims1-2 has not been given patentable weight because it is narrative in form. In order to be given patentable weight, functional recitation must be expressed as a "means" for performing the specified, as set forth in 35 USC 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional recitation. In re Fuller, 1929 C.D. 172; 388 O.G.279. With respect to claim 7, Gottwald

is capable of coating a substrate within the scope of claim since it teaches every positively claimed element of the apparatus.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is confusing since it is unclear what the term "carrying speed" is referring to. The recitation in claim 1 that W_2 is a coating amount after the strip-shaped body has passed the secondary bar is confusing since it is unclear whether one is claiming W_2 is the amount of excess coating left on the secondary roller as the strip –shaped body has passed or the amount available for application to the web. The recitation of the coating amount at the primary bar (W_2) in claim 1 is confusing since it is unclear what is supplying coating to the region at the primary bar since the primary bar is upstream of the reservoir.

Claim 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Brenda A Lamb at telephone number (571)-272-1231. The examiner can normally be reached on Monday and Wednesday thru Friday with alternate Tuesdays off.

Brenda A. Lamb

BRENDA A. LAMB
PRIMARY EXAMINER